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DOCKET NO. 45475-00026

PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Tae Heon Lee et al.

) Group Art Unit: 2811  
)

Serial No.: 09/687,048

) Examiner (Not Yet Known)  
)

Filing Date: October 13, 2000

)

For: LEADFRAME AND SEMICONDUCTOR PACKAGE WITH  
IMPROVED SOLDER JOINT STRENGTH

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Assistant Commissioner for Patents  
Washington, D.C. 20231

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CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.10  
EXPRESS MAIL RECEIPT NO. EL487170240US

I hereby certify that this correspondence is being deposited postage paid with the United States Postal Service as Express Mail in an envelope addressed to:

Box DAC  
Assistant Commissioner for Patents,  
Washington, D.C. 20231

on April 11, 2001

Signature of Sara J. Morrison

Dear Sir:

**Explanatory Letter of Supplemental Information  
for Pending Petition under 37 C.F.R. § 1.47(a)**

In accordance with M.P.E.P. § 409.03(d), the undersigned hereby submits this supplement to the Petition filed under 37 CFR § 1.47(a) on April 5, 2001 in connection with the above-identified application. The undersigned hereby requests incorporation of this letter of Supplemental Information into the Petition under 37 CFR §1.47(a) now pending in connection with the subject patent application.

As shown in the originally filed Petition and attached documents in support thereof, foreign counsel for both inventor Mu Hwan Seo (hereinafter "SEO") and ST Assembly Test Services, Inc. (hereinafter "STATS") refused to allow counsel for Amkor Technology Inc. (hereinafter "AMKOR") to contact SEO regarding this or other pending U.S. patent applications (*See* Exhibit B to the Verified Statement of Facts of Patent Attorney Paul W. Davis under 37 C.F.R. § 1.47(a) as filed with the Petition). AMKOR has a proprietary interest in the above-

identified patent application as defined in the originally filed Petition Under 37 C.F.R. § 1.47(a).

On April 5, 2001, U.S. counsel for STATS, who is also believed to be counsel for inventor SEO, indicated to AMKOR's counsel that inventor SEO is now, under certain circumstances, prepared to review patent applications filed by AMKOR in which he is a named inventor. AMKOR's counsel had mailed the Petition Under 37 C.F.R. § 1.47(a) on March 22, 2001. Further, U.S. counsel for STATS stated that SEO may be prepared to execute an inventor's declaration at the time of review. (See attached letter from Mr. A. James Isbester.)

The undersigned still requests action on the originally filed petition and statements in support thereof due to the approaching deadline for obtaining a filing date for the above-referenced application and hereby submits this information with respect to the attached letter from U.S. counsel for STATS in an effort to fully inform the United States Patent & Trademark Office all possible relevant facts, and to comply with the duty of candor before the United States Patent & Trademark Office.

Although the undersigned does not believe any fee is due in connection with the filing of this letter of supplemental information in the matter of the pending Petition, the undersigned hereby authorizes the debit of any fees due to Deposit Account No. 10-0447 of JENKENS & GILCHRIST, P.C. Please reference our docket number of 45475-00026 in connection with any debit to the deposit account. A duplicate copy of this sheet is attached hereto.

Respectfully Submitted,  
JENKENS & GILCHRIST, P.C.

*Robert W. Mason*

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T 89555-00001

**VIA FACSIMILE**

Jerry R. Selinger  
 Stanley R. Moore  
 Jenkens & Gilchrist  
 1445 Ross Avenue, Suite 3200  
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Re: *Amkor v. STATS*

Dear Messrs. Selinger and Moore:

As you know, we represent ST Assembly and Test Services, Ltd. ("STATS"), limited in connection with litigation pending between STATS and Amkor. In the course of our review of documents that maybe relevant to the dispute, we have had occasion to review correspondence between your firm and STATS or its counsel Davinder Singh at Drew & Napier regarding patent applications prepared on behalf of certain former employees of Anam, now employed by STATS.

As Mr. Singh has stated several times, STATS is concerned that its current employees not be unduly exposed to proprietary information of Anam or Amkor. For this reason, STATS has objected to your delivery of Anam patent applications to current STATS employees. At the same time, we understand Anam's desire to have its former employees, named inventors in certain patent applications, review those applications and execute appropriate inventor declarations or oaths. We therefore suggest a middle ground between your past practice of sending Anam these patent applications to the homes of STATS employees and STATS past position of objecting to its employees review of such documents.

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**GIBSON, DUNN & CRUTCHER LLP**

Jerry R. Selinger  
Stanley R. Moore  
Jenkens & Gilchrist  
April 5, 2001  
Page 2

Former Anam employees now employed by STATS are prepared to review patent applications on which they are named inventors in the offices of Anam's Singapore counsel. The individuals in question will not keep copies of these applications and will not make any notes or records of what they have reviewed. If the applications do accurately describe what they have done at Anam, they will be prepared to execute an inventor's declaration at the time of the review. In this manner, Anam can proceed with its patent prosecution efforts and, at the same time, both Anam and STATS can be assured that no proprietary information of Anam enters the STATS workplace.

Please let me know if you wish to pursue this approach.

Very truly yours,

*James Isbester /pb*  
A. James Isbester

AJI/pjb  
Enclosure(s)

cc: Looi Lee Hwa  
Davinder Singh

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